

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. SHULTZ

Appeal No. 96-3702
Application 08/208,688¹

ON BRIEF

Before ABRAMS, HAIRSTON, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application, filed March 11, 1994, for the reissue of U.S. Patent No. 5,255,435, granted October 26, 1993, based on Application 07/960,726, filed October 14, 1992.

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This appeal is from the final rejection of claims 1 through 21, all of the claims pending in this application for the reissue of U.S. Patent No. 5,255,435.

The invention relates to "a method and apparatus for removing bearings, such as automatic transmission bearing cones or bearing cups wherein the apparatus is adjustable to accommodate bearings of any size or diameter for removal by contacting the cup or cone on inner or outer surfaces thereof" (specification, column 1, lines 6 through 11). Claims 14 and 21 are of particular concern in this appeal and read as follows:

14. Apparatus for removing a bearing without removal of an internal mechanical part comprising:

an elongate bearing driving shaft;

contacting means axially and internally insertable through said bearing for contacting an annular bearing undersurface, said contacting means including a bearing-contacting shoulder, said contacting means being connected to said elongate driving shaft when operatively assembled for removing a bearing;

a mandrel expansion collar threadedly carried on said driving shaft for expanding an upper portion of said contacting means;

[tapered] adjusting means for adjusting said bearing driving shoulder, from an undersurface thereof, to a desired dimension to contact at least a portion of said annular bearing undersurface; and

thrust means for transmitting thrust from said driving shaft to said bearing drive shoulder such that rotation of said driving shaft forces said bearing undersurface upwardly for removal.

21. Apparatus for removing a bearing without removal of an internal mechanical part comprising:

an elongate bearing driving shaft;

contacting means axially and internally insertable through said bearing for contacting an annular bearing undersurface, said contacting means including a bearing-contacting shoulder, said contacting means being connected to said elongate driving shaft when operatively assembled for removing a bearing;

a mandrel expansion collar threadedly carried on said driving shaft for expanding an upper portion of said contacting means;

a mandrel spreader for adjusting said bearing driving shoulder, from an undersurface thereof, to a desired dimension to contact at least a portion of said annular bearing undersurface; and

thrust means for transmitting thrust from said driving shaft to said bearing drive shoulder such that rotation of said driving shaft forces said bearing undersurface upwardly for removal.

In essence, these two claims are amended versions of patent claim 14 and are identical thereto except that the term "tapered adjusting means" in patent claim 14 has been changed to "adjusting means" in appealed claim 14 and to "a mandrel spreader" in appealed claim 21. The record indicates that the appellant's purpose in advancing appealed claims 14 and 21 is to broaden the scope of coverage afforded by patent claim 14 (see, for example, the "Second Supplemental Reissue Application Declaration" submitted on October 11, 1995 as part of Paper No. 12).

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Claims 1 through 21 stand rejected under 35 U.S.C. § 251 as lacking statutory basis for reissue. According to the examiner,

[t]he statutory requirement of 35 U.S.C. § 251 does not authorize reissue of a patent unless the patent is deemed wholly or partially inoperative or invalid due to errors without deceptive intent. In this case, the patent is not deemed wholly or partially invalid or inoperative due to such errors because, based on the facts of record, claiming an "adjusting means" [appealed claim 14] or a "mandrel spreader" [appealed claim 21] has the same effect and/or scope as claiming a "tapered adjusting means" [patent claim 14], therefore there is no error. The courts have determined in In re Donaldson, 29 USPQ 2d 1845, 1850 (Fed Cir. 1994) that a means-plus-function limitation, under 35 U.S.C. §112 6th paragraph, is limited to corresponding structure, material or acts described in the specification and equivalents thereof. In this case, the tapered adjusting means, as patented, corresponds to the inverted truncated cone 58 as shown in figure 5 and described in the specification (column 6, lines 40 et seq.). This "adjusting means" has only been disclosed in the specification as such an inverted truncated cone 58, which can only be described as being "tapered" in shape. An adjusting means that does not have a tapered surface, as described by Applicant in the re-issue declaration, is not considered an art recognized, or structural, equivalent. Thus, a "tapered adjusting means" or an "adjusting means" or a "mandrel spreader", in light of Donaldson and Applicant's specification, have the same scope. Therefore, there is no error which would justify reissue [answer, Paper No. 17, pages 4 and 5].

Claim 21 also stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. Here, the examiner contends that "[i]n

claim 21, Applicant claims both 'a mandrel expansion collar' and 'a mandrel spreader'. This is mis-leading because the mandrel expansion collar actually corresponds to the same structural element as the mandrel spreader as disclosed, leading to confusion" (answer, Paper No. 17, page 5).

Reference is made to the appellant's main and reply briefs (Paper Nos. 16 and 18) and to the examiner's answer (Paper No. 17) for full statements of the respective positions of the appellant and the examiner with regard to the propriety of these rejections.²

The standing 35 U.S.C. § 251 rejection of claims 1 through 21, as explained in the excerpt from the answer reproduced above, is predicated on the examiner's determination that the recitations of the "adjusting means" in appealed claim 14 and "a mandrel spreader" in appealed claim 21 do not distinguish the respective scopes of these claims from that of patent claim 14 with its recitation of a "tapered adjusting means." Thus, the examiner concludes that there is no error which justifies the reissue of appellant's patent.

² The examiner has withdrawn the 35 U.S.C. § 251 rejection of claims 1 through 21 as being based on a defective reissue declaration and the 35 U.S.C. § 112, first paragraph, rejection of claim 21 which were set forth in the final rejection (see the advisory action dated November 8, 1995, Paper No. 13).

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In reissue proceedings, claims are given their broadest reasonable interpretation consistent with the specification. In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984); In re Reuter, 670 F.2d 1015, 1019, 210 USPQ 249, 253-54 (CCPA 1981). For claim limitations written in means-plus-function format, the broadest reasonable interpretation is that which is mandated by 35 U.S.C. § 112, sixth paragraph, i.e., such limitations cover or are limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson Co., 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994).

The "tapered adjusting means" recitation in patent claim 14 is a means-plus-function limitation which is limited to corresponding "tapered" structure described in the specification (inverted truncated cone 58) and "tapered" equivalents thereof. The "adjusting means" recitation in appealed claim 14 is a means-plus-function limitation which is limited to corresponding structure described in the specification (inverted truncated cone 58) and equivalents thereof which are not necessarily tapered. The "mandrel spreader" recitation in appealed claim 21 is not a means-plus-function limitation and thus is not limited to the corresponding structure described in the specification (inverted

truncated cone 58) and equivalents thereof. Thus, on the face of it, the "mandrel spreader" recitation in appealed claim 21 is broader than the "adjusting means" recitation in appealed claim 14, which in turn is broader than the "tapered adjusting means" recitation in patent claim 14. In other words, appealed claims 14 and 21 seemingly are of broader scope than patent claim 14. Since the examiner has not advanced any evidentiary basis to support his determination to the contrary, we shall not sustain the standing 35 U.S.C. § 251 rejection of claims 1 through 21 as lacking statutory basis for reissue.

Nor shall we sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 21.

The second paragraph of § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Suffice it to say that when the "mandrel expansion collar" and "mandrel

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spreader" recitations in claim 21 are read in the context of their surrounding claim language and in light of the underlying disclosure, it is quite clear that the "mandrel expansion collar" reads on disclosed element 16, 16a and that the "mandrel spreader" reads on disclosed element 58. The fact that the terminology used in the specification to describe these elements might be somewhat inconsistent with the terminology used in the claim is not sufficient in this case to render claim 21 indefinite.

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In light of the foregoing, the decision of the examiner to reject claims 1 through 21 under 35 U.S.C. § 251 and claim 21 under 35 U.S.C. § 112, second paragraph, is reversed.

REVERSED

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NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
KENNETH W. HAIRSTON)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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